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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,965	04/25/2006	Hidekazu Hoshino	127846	2790
25944 7590 02/25/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
KILPATRICK, BRYAN T				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
02/25/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,965

**Applicant(s)**

HOSHINO ET AL.

**Examiner**

BRYAN T. KILPATRICK

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed 16 December 2008 has been entered and fully considered.
2. A terminal disclaimer has been entered and fully considered.
3. The nonstatutory obviousness-type double patenting rejection has been withdrawn.
4. Claims 1-11 are pending.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 16 December 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 7,388,627 (HOSHINO et al.) has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being obvious over  
European Patent 1,028,359 A1 (SHIOZAWA et al.).

Instant claim 1 recites a discrimination medium comprising a cholesteric liquid crystal layer and a multilayer film. Instant claims 2 and 3 require reflections of light off the cholesteric liquid crystal layer and multilayer film; approximately equal to each other in color for instant claim 2 and different from each other in color for instant claim 3, respectively. SHIOZAWA et al. discloses circular polarized light selectivity in the Abstract, and paragraphs [0030]-[0041] disclose the use of cholesteric liquid layers and films having multiple layers. Also, SHIOZAWA et al. discloses a method of producing a hologram (which the prior art defines as a pattern, image, or characters in the first line of paragraph [0062]) on an authenticity identifying film comprised of multiple layers: a reflective film (which has a cholesteric liquid crystal layer or phase), a protective film, a light absorbing film, and a base film in paragraphs [0046]-[0057]. SHIOZAWA et al. is from the field of endeavor of authenticity identification. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method of authenticity identifying via colors since it was known in the art of a method of authenticity identifying via a hologram. The motivation would have been to provide an authenticity identifying film having a highly esthetic design and facilitating visual authenticity identification, as disclosed in paragraph [0007]. Therefore, the invention as

a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made. In addition, the invention of the prior art has all the components of the current instant application; it has been held that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); MPEP 2114 Apparatus and Article Claims, Functional Language

Instant claim 4 requires a figure to be provided to at least a portion of one of the layer and film. Instant claim 5 requires hologram working or embossing. Instant claim 6 requires interlayer peeling structure or a peeling breaking structure. Instant claim 7 requires an article to be discriminated having the discrimination medium. Paragraph [0003] of SHIOZAWA et al. discloses the use of characters and patterns similar to the figures and characters stated by the current instant specification in paragraph [0003]. Paragraphs [0012]-[0013] of SHIOZAWA et al. disclose an embossed hologram and an authenticity identifying film attached to an article via an adhesive layer. Paragraph [0099] of SHIOZAWA et al. discloses the use of a form of peeling breaking for preventing the reuse of a discrimination medium.

Instant claims 8-11 disclose the use of a discrimination medium comprised of layers and films being analyzed by a device having an optical filter, a light irradiation device, and a light detector. The Abstract, paragraphs [0019]-[0022], and [0085]-[0091] of SHIOZAWA et al. disclose the use of these type of components in a system for authenticity identification.

### ***Response to Arguments***

Applicant's arguments filed 16 December 2008 have been fully considered but they are not persuasive.

Applicant argues that SHIOZAWA et al. fails to teach or suggest the multilayer film recited in the filed amended claims 1 and 8-11. As previously stated, SHIOZAWA et al. teaches circular polarized light selectivity in the Abstract, and paragraphs [0030]-[0041] disclose the use of cholesteric liquid layers and films having multiple layers. In addition, the invention of the prior art has all the components of the current instant application; it has been held that the manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); MPEP 2114 Apparatus and Article Claims, Functional Language

Applicant argues that SHIOZAWA et al. fails to teach a discrimination medium that reflects polarized light. SHIOZAWA et al. teaches the reflection for right-handed and left-handed polarized light in paragraph [0031]. The prior art also addresses the argument of linearly polarized light since it is known in the art that linearly polarized waves may be resolved into two circularly polarized waves having the equal magnitude and their planes of polarization at right angles to each other.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN T. KILPATRICK whose telephone number is (571)270-5553. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel P Siefke/  
Primary Examiner, Art Unit 1797

BK  
AU 1797